

REMARKS

The Office Action dated April 18, 2007 has been reviewed, and the comments of the U.S. Patent Office have been considered. Claims 1-33 are pending in this application.

Claims 1-33 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting over claims 1-37 of co-pending Application No. 10/726,464. The rejection is respectfully traversed.

The Office Action at pages 2-3 asserts only that instant claims 1-33 are not patentably distinct from claims 1-37 of the '464 application because:

... the longitudinal length and the interior surface area are measurements. One of ordinary skill in the art would not expect these devices to perform differently ... they are measurements of the same area of the device. They are both measurements of the same medical balloon.

Assuming, *arguendo*, that the rejection is based on a comparison of the scope of instant claims 1-33 to the scope of claims 1-37 of the '464 application, Applicant respectfully traverses the rejection because the scope of the claims, by itself, cannot support a double patenting rejection. *See MPEP §804(II).*

Applicant also traverses the rejection because the Office Action fails to establish a *prima facie* case of obviousness. The burden is on the Office to establish a *prima facie* case of obviousness as to why one of ordinary skill in the art would conclude that the inventions recited in instant claims 1-33 are an obvious variant of the invention recited in claims 1-37 of the '464 application. That is, there must be an apparent reason for a person of ordinary skill in the art to modify the invention recited in claims 1-37 of the '464 application in order to reach the invention recited in instant claims 1-33, and the Office must provide an explicit analysis identifying the reason. *See USPTO Memorandum to Technology Center Directors of May 3, 2007 at page 2.* Applicant respectfully submits that there is no reason provided by the Office, and the Office Action thus fails to establish a *prima facie* case of obviousness.

Furthermore, "longitudinal length" and "interior surface area" define different parameters and are not "measurements of the same area of the device" as asserted in the Office Action at page 3 (emphasis added). Contrary to the position of the Office Action, Applicant submits that the measurement of length (which involves the measurement of a single dimension) is not the

same as the measurement of area (which involves a calculation based on one or more dimensions).

Accordingly, the double patenting rejection should be withdrawn.

Claims 1-14, 17-28, and 30-31 stand rejected under 35 U.S.C. §102(e) over Hamilton (U.S. Pat. No. 5,797,877); and claims 15, 16, 29, 32, and 33 stand rejected under 35 U.S.C. §103(a) over Hamilton. The rejections are respectfully traversed.

MPEP §2136.02(II) states (emphasis added):

When a U.S. patent, a U.S. patent application publication, or an international application publication is used to reject claims under 35 U.S.C. 102(e), the disclosure relied on in the rejection must be present in the issued patent or application publication.

Independent claim 1 recites, among other things, a non-compliant medical balloon having a first fiber layer having fibers, and a second fiber layer having fibers. Independent claim 18 recites, among other things, a non-compliant medical balloon having a first fiber and a second fiber. Hamilton fails to show or describe a medical balloon having fibers. The term "fiber" does not appear in Hamilton, and there is no showing or description of a fiber or a fiber layer. Hamilton is limited to layers made of a polymer material, without any mention of fibers. *See* Hamilton at col. 3, lines 2-65. Hamilton at most describes the use of thermoplastic elastomers, which are described as having "randomized block copolymers having polyester crystalline hard segments and amorphous glycol soft segments." *See* Hamilton at col. 3, lines 48-50. However, even with that description of material characteristics, nowhere does Hamilton mention the presence of fibers. Accordingly, with regard to fibers, Hamilton does not have a "disclosure ... present in the issued patent" (Hamilton) that supports a rejection under 35 U.S.C. §102(e).

Likewise, independent claim 1 recites, among other things, a non-compliant medical balloon having a first fiber layer having at least one fiber disposed along a longitudinal length of the non-compliant medical balloon and a second fiber layer disposed over the first fiber layer such that the fibers of the first fiber layer and the fibers of the second fiber layer form an angle. Independent claim 18 recites, among other things, a non-compliant medical balloon having a first fiber positioned over the base layer in parallel relation to the longitudinal axis of the balloon, the first fiber having a first fiber length corresponding to a longitudinal length of the balloon and a second fiber wound radially over the base layer and over the first fiber along at least a portion of

the longitudinal axis of the balloon. Hamilton fails to show or describe a medical balloon having fibers disposed along the length of the balloon, having a fiber length corresponding to the length of the balloon, having a fiber wound radially over the balloon, or having fibers disposed at angles relative to each other. Accordingly, Hamilton fails to provide a disclosure that supports a rejection under 35 U.S.C. §102(e).

At page 4 of the Office Action, the Office asserts that Hamilton shows fibers at Fig. 1 of Hamilton, and that "PET is a type of fiber". Both of these assertions are respectfully traversed. As stated above, Hamilton does not describe layers 34 and 36 to include a fiber or to be a fiber layer, and the drawing in Fig. 1 does not show a fiber or a fiber layer. Also, the Office fails to properly establish that "PET is a type of fiber". Moreover, the unestablished position is respectfully traversed because PET is actually a type of polymer that can take many forms that would not constitute a "type of fiber". Furthermore, the Office's assertion is apparently based on the Examiner's understanding of PET and is thus not "present in the issued patent" as required by MPEP §2136.02(II). Accordingly, the Office's assertions can not be used as a basis of rejection under 35 U.S.C. §102(e).

For at least the foregoing reasons, the rejections of independent claims 1 and 18 fail to meet the requirements of 35 U.S.C. §102(e) or MPEP §2136.02(II), and it is respectfully requested that the rejections of the independent claims be withdrawn. As the dependent claims contained the allowable subject matter recited in independent claims 1 and 18, it is also respectfully requested that the rejections of the dependent claims be withdrawn.

With regard to the dependent claims, and in addition to the above, Hamilton fails to show, describe, teach, or suggest the features recited in dependent claims 2-17 and 19-33, and the Office has failed to provide an explicit analysis identifying a reason that would have prompted a person of ordinary skill in the relevant field to modify Hamilton as asserted in the Office Action.

With regard to dependent claims 2-14, 17, 19-28, and 30-31, which stand rejected under 35 U.S.C. §102(e), Hamilton fails to show or describe the recited fibers or fiber layers, or the recited angles and orientations of fibers and fiber layers. At pages 4-5 of the Office Action, the Office appears to assert that Hamilton's Figs. 1, 2a, and 2d show fibers, fiber layers, and an arrangement of fibers and fiber layers. However, as stated above, Hamilton does not describe

layers 34 and 36 to include a fiber or to be a fiber layer, and the drawings in Figs. 1, 2a, and 2d do not show a fiber, a fiber layer, or any arrangement of fibers and fiber layers.

With regard to dependent claims 15, 16, 29, 32, and 33, which stand rejected under 35 U.S.C. §103(a), Hamilton fails to show, describe, teach, or suggest the recited wind density, angles, quantity of fibers, and fiber lengths, and the Office has failed to provide an explicit analysis identifying a reason that would have prompted a person of ordinary skill in the relevant field to modify Hamilton as asserted in the Office Action. Specifically, the Office fails to set forth any reason as to why a person of ordinary skill would have modified Hamilton to add the recited wind density, angles, and quantity of fibers, or to add the fibers and fibers layers recited in the independent claims.

Furthermore, in the Office Action at page 5, the Office acknowledges that Hamilton fails to show or describe the recited "winding density and ranges in lengths of the sets of fibers". The Office then limits its analysis to only the purported recitation of "relative dimensions", but dimensions are not recited in claims 15, 16, 29, and 32 as these claims regard wind density, angles, and quantity of fibers. Of the claims rejected under §103(a), only claim 33 recites a fiber length. The Office thus fails to provide an explicit analysis identifying a reason supporting the rejection of at least claims 15, 16, 29, and 32.

With regard to the §103(a) rejection of dependent claim 33, the Office asserts at page 5 that Hamilton would have been modified by a person of ordinary skill "to obtain the current invention because such a modification [of fiber length] would be considered a mere design choice". However, the Office fails to provide an explicit analysis identifying a reason why a person of ordinary skill would modify Hamilton to add fibers, or to add fibers of the recited fiber lengths.

For the foregoing reasons, Hamilton fails to show, describe, teach, or suggest all of the features recited in the independent claims or the dependent claims thereof. It is respectfully requested that the rejection be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this Application and the prompt allowance of at least claims 1-33.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the undersigned to expedite prosecution of the application.

The Commissioner is hereby authorized by this paper to charge any fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-3840. **This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).**

Respectfully submitted,



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